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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/983,054	10/16/2001	Jagadish C. Sircar	AVANIR.C61CP3	8193
20995	7590	05/04/2005		
KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614				
			EXAMINER KIM, VICKIE Y	
			ART UNIT	PAPER NUMBER
			1614	

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Response to Rule 312 Communication**

Application No.

09/983,054

Applicant(s)

SIRCAR ET AL.

Examiner

Vickie Kim

Art Unit

1614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

1. ☒ The amendment filed on 01 July 2004 under 37 CFR 1.312 has been considered, and has been:

a) ☐ entered.

b) ☐ entered as directed to matters of form not affecting the scope of the invention.

c) ☐ disapproved because the amendment was filed after the payment of the issue fee.

Any amendment filed after the date the issue fee is paid must be accompanied by a petition under 37 CFR 1.313(c)(1) and the required fee to withdraw the application from issue.


d) ☒ disapproved. See explanation below.

e) ☐ entered in part. See explanation below.

Newly added claims 17-19 are subject to double patenting rejection because they are duplicated claims of claims 5 and 15-16, respectively. The scope both corresponding claims are substantially same where the duplicate claims can not be allowed.3. Applicant is advised that Claims 17-19 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 5 and 15-16. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). For example, the claims 16 and 19 are a pharmaceutical composition contains the compound 1256. The scope of both claims 16 and 19 are substantially same and thus, the claims would be subjected to objection. Thus, the new claims 17-19 will not be entered.

In addition to that, the scope of the claims 17-19 are not clear whether the claims are directed to the compound of composition. For instance, the claim 17 relates to a pharmaceutical composition selected from the group consisting of various compounds. The composition is patnetably distinct from a compound where the composition should be made of an active principal(i.e. compounds as recited) and other carriers or excipients. The new claims 17-19 seems lacking clear distinction between compound and composition. For the reasons above, the 312 amendment will not be entered.

**VICKIE KIM**  
**PRIMARY EXAMINER**



Vickie Kim  
Primary Examiner  
Art Unit: 1614